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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,046	01/22/2001	Francesco Cocola	70012	4570

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MCGLEW & TUTTLE, PC  
SCARBOROUGH STATION  
SCARBOROUGH, NY 10510

EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/767,046

Applicant(s)

COCOLA ET AL.

Examiner

Dwayne K Handy

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1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-9, 12-15, 19-23 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29, 30, 32 and 33 is/are allowed.
- 6) ☒ Claim(s) 2, 5, 6, 12, 15, 19-23, 25, 27, 28, 31, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 7-9, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Applicant is again reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 09/194,090 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be made in this application. In making such claim, applicant may simply identify the application containing the priority papers.

### *Double Patenting*

2. Claims 19-23, 2-9 and 12-15 were previously rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-5 and 9-20 of U.S. Patent No. 6,190,615. This rejection has been lifted in light of applicant's submission of a Terminal Disclaimer on 8/26/03.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 5, 6, 12, 13, 19-23 and 25 were previously rejected under 35 U.S.C. 102(b) as being anticipated by Engelhardt (3,680,967). **This rejection has been removed in light of applicant's amendment submitted 8/26/03.** Engelhardt

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does not teach a receptacle or test tube with two substantially flat and parallel opposite walls.

***Inventorship***

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 2, 5, 6, 12, 15, 19-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhardt (3,680,967) in view of Kurosaki et al. (5,658,532). Engelhardt teaches a liquid sample receptacle with an integral label portion carrying machine-readable indicia identifying the sample source and located substantially parallel to the longitudinal axis of a cup portion. The sample receptacle is structured with respect to the turntable unit to properly align the machine-readable indicia for automatic readout (Abstract). The receptacle is best shown in Figures 1A-1C and described in column 3. The sample receptacle (1) include an elongated cylindrical cup portion (3), formed of plastic or other inert material, having an inverted conical bottom (5) raised slightly above lower extremity. A connector portion (9) is attached to and collars cup portion (3) slightly below its upper extremity (11). Also, connector portion (9) is joined along its wider curved edge (15) to label portion (17). Label portion (17) is slightly curved and the outer surface supports coded indicia identifying the source individual from whom a contained sample was taken. Figure 2 shows the information being read from the receptacle. Engelhardt does not teach a container with a pair of opposing walls in a rectangular shape.

Kurosaki et al. (5,658,532) teaches a cuvette and cuvette-transporting apparatus. The cuvette of Kurosaki is transparent (col. 2, line 48) and is best shown in Figures 1 and 2 and contains a square or rectangular portion which is used to control the position or alignment of the cuvette during its rotation (col. 2, line 52 – col. 3, line 10). It would

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have been obvious to add the feature of a rectangular shape comprised of two pairs of parallel sides from the cuvette of Kurosaki to the container of Engelhardt. The addition of this feature would allow for aligning the cuvette for examination as taught by Kurosaki.

***Allowable Subject Matter***

7. Claims 29, 30, 32, and 33 are allowed.
8. Claims 3, 4, 7-9, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 3, 29, and 30 recite a cylindrical connecting part projecting from the body for filling the cuvette. This feature is not shown in the prior art.

Claims 4, 7, 13, 14, 32 and 33 recite either the feature of the indicia wall being integral with the container body or multiple indicia walls. These features are also not shown in the prior art.

***Response to Arguments***

9. Applicant's arguments filed 8/26/03 have been fully considered and while they are persuasive in arguing that Engelhardt does not teach opposing parallel walls, they are not persuasive in arguing against several of the other features cited by applicant. Again the Examiner wishes to state that the Examiner agrees with applicant that the reference Engelhardt does not teach opposing parallel walls. The Examiner has added

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a secondary reference, Kurosaki, to make up for this shortcoming. There are other features broadly claimed by applicant that the Examiner believes **are** present in this reference. For example, Engelhardt's indicia wall extends in a flat zone that projects from the container body. This is recited in various ways in claims 5, 6, 12, 19-23 and 25. In each of these claims the only requirement on the indicia wall is that it be connected to the container body and be parallel to the container body, the detection rays (non-limiting) or the axis of the container. This feature is present in Engelhardt. The fact that Engelhardt shows an indicia wall that is not completely integral with the container body is not required to meet the limitations in the instant claims that remain rejected. The Examiner notes that claims containing this feature would be allowable or have been allowed.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Abend et al. (5,870,182), Gross (4,332,471), and Sharma (4,319,882) show examples of rectangular cuvettes.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (703)-305-0211. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703)-308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

Dkh  
November 17, 2003

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700